



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/876,666

06/07/2001

Motoi Sato

44471-259522 (13700)

9577

23370 7590 02/26/2008

JOHN S. PRATT, ESQ
KILPATRICK STOCKTON, LLP
1100 PEACHTREE STREET
ATLANTA, GA 30309

EXAMINER

CHAMPAGNE, DONALD

ART UNIT

PAPER NUMBER

3622

MAIL DATE

DELIVERY MODE

02/26/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/876,666	Applicant(s) SATO ET AL.	
	Examiner Donald L. Champagne	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 1-14 and 24-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-17 and 19-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 18 September 2007 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 15-17 and 19-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. At lines 4-5 of claims 15 and 22, and at lines 6-7 of claim 23, "an advertisement sponsor, which is different than the information provider," is new matter of the "negative limitation" kind (MPEP § 2173.05(i)).

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 15-17 and 19-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. At lines 4-5 of claims 15 and 22, and at lines 6-7 of claim 23, "an advertisement sponsor, which is different than the information provider," is indefinite.

Art Unit: 3622

6. The claimed distinction between "an advertisement sponsor" and "the information provider" is interpreted to be based on ownership. Ownership is inherently indefinite because it is not concrete (predictable). The US Supreme Court has ruled that "A corporation is an artificial being, invisible, intangible and existing only in contemplation of law." *CTS Corp. v. Dynamics Corp. of America*, 481 U.S. 69, 89, 107 S. Ct. 1637, 1649-1650 (1987) (citing *Trustees of Dartmouth College v. Woodward*, 17 U.S. (4 Wheat) 518 (1819)). A business entity can be created, merged, dispersed or destroyed at human whim.
7. Assume that a patent was granted with the claims limited to "an advertisement sponsor, which is different than the information provider" and applied to some certain business entities. What would happen if one of these two entities bought the other? Does the patent suddenly become invalid? Further, does the patent regain its validity if the merged company is later broken up? And, what would happen if some third entity bought 50% of each the advertisement sponsor and the information provider? Would the advertisement sponsor and the information provider now be "half different"?

Claim Rejections - 35 USC § 102 and 35 USC § 103

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3622

10. Claims 15-17, 22 and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Linden et al. (US006266649B1).

11. Linden et al. teaches (independent claims 15, 22 and 23) a method, device and computer readable medium for providing an advertisement, the method comprising:

managing access logs (records of a *user's purchase history*, col. 7 lines 24-33) for accesses (*purchases*) made by users with respect to information provided by an information provider (a *recommendation service*, col. 7 lines 6-8), and advertisement information provided by an advertisement sponsor (inherently, para.13below), for some product "B" recommendation (col. 11 lines 54-56) the advertisement information is to be provided to a client who is a user accessing target information specified in advance by the advertisement sponsor (product "A" *contents of the user's shopping cart*, col. 3 lines 38-40 and col. 4 line 66 to col. 5 line 1), where the advertisement information is provided with the information provided by the information provider (inherently, because the two entities are the same, para.13 below) and where the product "B" recommendation advertisement information is associated with additional information of the advertisement sponsor (the product "B" recommended item's *product information page*, col. 11 line 52) that can be accessed by the user client from the advertisement information (col. 11 lines 50-52);

adding access logs of other purchaser users who are advertisement agent virtual users accessing both the product "A" target information and the product "B" additional information (col. 3 lines 1-3);

providing the advertisement on behalf of the advertisement sponsor in response to a request from the client (the client making said request implicitly by adding product "A" to his or her shopping cart, col. 10 lines 39-43), by detecting the advertisement agents as related users who made accesses to the product "A" target information besides the client according to the access logs (col. 3 lines 1-3), extracting the additional information as correlated information that is accessed by the related users according to the access logs (col. 2 line 57 to col. 3 line 1 and col. 10 lines 37-39, col. 10 line 64 to 66), and delivering the advertisement information managed in association with the additional information as extracted, to the client (col. 11 lines 38-39, 49-50 and 54-56).

For claim 22, Linden et al. also teaches an ad providing server (*Web Server 32*, Fig. 1 and col. 7 line 11).

Art Unit: 3622

- 12. Interpretation of claim terms** - Unless a term is given a “clear definition” in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so “with reasonable clarity, deliberateness, and precision” (MPEP § 2111.01.III). A “clear definition” must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as “by xxx we mean”; “xxx is defined as”; or “xxx includes, ... but does not include ...”. An example does not constitute a “clear definition” beyond the scope of the example.
13. The instant application contains no such clear definition for the phrases “advertisement sponsor” or “information provider”. Hence, the examiner is required to give these terms their broadest reasonable interpretation. The examiner interprets “advertisement sponsor” as any entity that promotes a product/service, said promotion being the advertisement. The *recommendations service* taught by Linden et al. reads on an “advertisement sponsor”, where the product/service *recommendation* reads on an advertisement. By definition, “advertisement information” is “of an advertisement sponsor”. An “information provider” is interpreted as any entity that provides information. The *recommendations service* taught by Linden et al. also reads on an “information provider”. An “advertisement providing server” is interpreted as a computer which delivers promotional information to other computers; *Web Server 32* (Fig. 1) reads on that.
14. The limitation “target information specified in advance by the advertisement sponsor” is also not clearly defined in the spec., and is interpreted as the *contents of the user’s shopping cart* taught by Linden et al. The accumulation of the shopping cart data (col. 4 line 66 to col. 5 line 1) reads on “specified in advance”.
15. Linden et al. also teaches at the citations given above claim 17. Linden et al. also teaches claim 16, where the periodic (e.g., *weekly*) updating of the *mappings of items to similar items* (col. 5 line 57 to col. 6 line 2) reads on detecting other related users. The continual accumulation of purchase histories reads on adding access logs of other advertisement agents.

Art Unit: 3622

16. Claims 19-21 are rejected under 35 U.S.C. 103(a) as obvious over Linden et al. in view of Yonezawa et al. (US 20030191742A1). Linden et al. does not teach charging an advertisement fee for a minimum advertisement information delivery count. Yonezawa et al. teaches charging an advertisement fee for a minimum advertisement information delivery count (para. [0008]). Because Yonezawa et al. teaches that this enables better management of time-sensitive advertising (para. [0021]), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Yonezawa et al. to those of Linden et al. Neither reference teaches (claim 21) refunding at least part of the advertisement fee. However, refunding is always an obvious alternative when contract terms cannot be met.

Response to Arguments

17. Applicant's arguments filed with an amendment on 18 September 2007 have been fully considered but they are not persuasive. The arguments have been addressed by the revised rejection. The following additional comments are offered in the event that applicant chooses to continue prosecution.
18. The limitation "an advertisement sponsor, which is different than the information provider," cannot impart patentability because it is new matter, indefinite and non-functional (para. 2-7 and 12 above). However, the application does disclose distinct "information provider" and "advertisement" servers (e.g., respectively as item **110** in Fig. 1 and as item **1120** in Fig. 11). Hence the applicant could claim distinct servers, but it is not clear to the examiner if this would be helpful. It could be helpful if the spec. gave functional justification for the separation. Merely calling two "servers" by different names cannot of itself establish a patentable distinction over the prior art.

Conclusion

19. This is a continuation of applicant's earlier Application No. 09876666. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 3622

20. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L. Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 9:30 AM to 8 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717. The fax phone number for all *formal* matters is 571-273-8300.
22. The examiner's supervisor, Eric Stamber, can be reached on 571-272-6724.
23. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
24. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that “disposal or clarification for appeal may be accomplished with only nominal further consideration” (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.

Art Unit: 3622

25. Applicant may have after final arguments considered and amendments entered by filing an RCE.

26. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

/Donald L. Champagne/
Primary Examiner, Art Unit 3622

14 February 2008